

**REMARKS**

Claims 1-2 are pending. Applicants respectfully submit that no new matter is presented herein.

In view of the Final Office Action dated April 3, 2006, the June 28, 2006 dated Response thereto, and the Advisory Action dated July 18, 2006, Applicants respectfully submit that this Submission, which is supplemental to and to be taken into consideration with the Response dated June 28, 2006, places the instant application in condition for allowance.

Prompt and favorable examination on the merits is respectfully requested.

Applicants respectfully point out that the Final Office Action dated April 3, 2006 rejected Claims 1-4 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,732,128 to Statham. The June 28, 2006 Response traversed the rejection for reasons which are incorporated herein in their entirety.

The Advisory Action dated July 18, 2006 asserted that the newly proposed pressure range recited by Claim 1 in the June 28 Response has never appeared in the claims and thus raises a new issue requiring further consideration and/or search on the part of the Examiner. Thus, the instant RCE is being filed so the Examiner may properly consider the amendments to Claim 1.

The Advisory Action also asserted that the amendment to Claim 1, which recites the pressure P is greater than 10,000 psi, reads on 10,000 psi. Applicants strongly disagree with this assertion as it appears to be contrary to well established patent law.

In particular, Applicants note the June 28 Response amended Claim 1 to recite "pressure P is in a range of 10,000 PSI < P ≤ 29,000 PSI." As is clear from the recited range, the pressure P is greater than 10,000 Psi and does not touch the 10,000 PSI value, especially since the recited range uses the greater than symbol, < , and not the greater than or equal to symbol, ≤ .

Moreover, M.P.E.P. §2113.03, in particular, section III, states that prior art which teaches a value or range that is very close to, but does not overlap or touch, the claimed range does not anticipate the claimed range.

Furthermore, "anticipation under §102 can be found only when the reference discloses exactly what is claimed and that where there are differences between the reference disclosure and the claim, the rejection must be based on §103 which takes differences into account." Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). For the Examiner's edification, this is a case where the claims were directed to a titanium (Ti) alloy with 0.8% nickel (Ni) and 0.3% molybdenum (Mo) that were held not anticipated by, although they were held obvious over, a graph in a Russian article on Ti-Mo-Ni alloys in which the graph contained an actual data point corresponding to a Ti alloy containing 0.25% Mo and 0.75% Ni.

In the presently claimed invention, Applicants respectfully submit that the originally filed application clearly states that the applied pressure is more effective at a higher value of the range. As such, Applicants point out Claim 1 recites a range which is not overlapped by the range taught by Statham, i.e., the pressure range exceeding Statham's upper limit of 10,000 psi. The recited range is not an obvious variance of the teachings of Statham because Statham suggests (column 1, lines 55-60) that a higher

pressure would result in the Statham die casting to blister, which is an undesirable effect during heat treatment and which would adversely affect the Statham die casting. Therefore, Applicants respectfully submit one of ordinary skill in the art would not be motivated to use a higher pressure, such as the pressure range recited by Claim 1.

For the reasons discussed above, Applicants respectfully submit that Statham fails to disclose or suggest each and every feature recited by Claim 1.

To qualify as prior art under 35 U.S.C. §102, a single reference must teach, i.e., identically describe, each feature of a rejected claim. As such, because Statham fails to teach or suggest each and every feature recited by Claim 1 as required by M.P.E.P. §2143.03 to establish *prima facie* obviousness of a rejected claim, Applicants submit Statham does not anticipate nor render obvious the invention recited by Claim 1 of the instant application. Accordingly, respectfully submits Claim 1 should be deemed allowable over Statham.

Claim 2 depends from Claim 1. It is respectfully submitted that the dependent claim should also be deemed allowable for the reasons Claim 1 is allowable as well as for the additional subject matter recited therein.

Applicants respectfully request withdrawal of the rejection.

### **Conclusion**

In view of the foregoing, reconsideration of the application, withdrawal of the outstanding rejection, allowance of Claims 1-2, and the prompt issuance of a Notice of Allowability are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing docket number 107348.00363.**

Respectfully submitted,

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